

REMARKS

In this 1st Official Action, the Patent Examiners of record have taken all of the following actions:

(i) The Examiners have objected to the Specification/Drawing for failing to meet the requirements of 37 CFR 1.84.

(ii) The Examiners have rejected original claims 7 and 21 respectively under 35 USC 112, 2nd paragraph as being indefinite in language for specifically stated reasons.

(iii) The Examiners have rejected original independent claims 1, 2, 15, 16, and 17 respectively, as well as the original dependent claims which depend from them, under 35 USC 102(b) as being anticipated by the Miyake *et al.* 2000 publication.

(iv) The Examiners have rejected original dependent claims 12 and 26/16-17 under 35 USC 103(a) as being obvious over the Miyake *et al.* 2000 publication in view of the Bales *et al.* '303 patent [U.S. Patent No. 5,233,303].

(v) The Examiners have objected to original claims 3, 4/3, 5/3, 6, 10, 13, 20/16-17, and 24/16-17, but state that these claims would be allowable if rewritten in independent form and to include all the limitations of the base claim and any intervening claims.

(vi) The Examiners have allowed original claims 18, 19/18, 20/18, 23/18, 24/18, 25/18, 26/18, and 27/18 as originally worded.

In response, applicants have taken the following actions:

(α) Applicants gratefully acknowledge and formally accept the Examiners' allowance of original claims 18, 19/18, 20/18, 23/18, 24/18, 25/18, 26/18, and 27/18.

(β) Applicants have canceled original independent claims 1-2 and 15-17, without prejudice.

(γ) Applicants have amended original claims 3-14 and 19-27 respectively.

(δ) Applicants have retained dependent claims 5 and 13 respectively as originally worded.

Accordingly, via the present cancellations and amendments to the originally presented claims ,as well as by the discussion presented hereinafter, applicants believe they have overcome and obviated each basis for objection and rejection stated by the Examiners in the instant 1st Official Action.

I. Applicants' Intentions And Goals

Applicants and their undersigned attorney wish to state their intentions clearly to the Examiner of record. It is our express desire and purpose to advance the prosecution of the instant application on the merits, and not to delay or hinder its progress unnecessarily.

To achieve this goal, applicants have therefore canceled original

independent claims 1-2 and 15-17, without prejudice; and amended original claims 3-4, 6-12, 14, and 19-27 respectively of the application. Via these specific claim cancellations and amendments, applicants have altered the definition of the subject matter as a whole comprising the instant invention; and also provide an amended set of claims which has been changed in format to recite that language stated previously by the Examiners to be allowable subject matter.

Concomitant with these specific claim cancellations and amendments, applicants will also directly summarily address each basis for objection and rejection stated by the Examiners in the instant Official Action.

II. The Examiners' Objection To The Specification/Drawing

The Examiners have objected to the Specification/Drawing as failing to conform to the requirements set forth by 37 CFR 1.84.

In the main, applicants note that the Examiners have ample cause for their objection. However, applicants wish to point out several features in the Drawing as originally submitted.

Initially, applicants undersigned attorney respectfully submits that many electronically produced visual images have been routinely accepted in recent years as formal figures in a Drawing without need for their being submitted as "photographs" mounted separately upon boards in triplicate. The electronically reproduced images consistently provide clear and distinct

figures; and are easily reproduced as black and white images for patent issuance and printing purposes. Accordingly, applicants respectfully request the Examiners to accept electronic images where appropriate, instead of requiring applicants to petition for the submission mounted photographs in triplicate as such.

Second, applicants respectfully submit that no color photographs as such have been submitted to date as any figure in the original Drawing. Applicants do acknowledge that some of the original black & white figures [as exemplified by original Figs. 1A, 3A-3E, 15A-15C, 16A-16C, 17A-17C, as well as others] have somewhat dark backgrounds and can be better prepared in black & white contrasts and image brightness. It is also applicants' intention to provide substitute figures having improved black & white contrasts and image brightness.

Third, applicants acknowledge that some of the graphs in the original figures have dark, rather than completely white, backgrounds. It is applicants' intention to correct this defect in the near future; and to provide graphs having only a white background as substitute figures.

Based on all the foregoing, applicants respectfully request that the Examiners accept applicants' assurances that the various defects presently existing in the original Drawing will be corrected; but also ask the Examiners to defer this ground of objection against the Specification/Drawing until the claims of the instant application are allowed and prosecution on the merits is

closed. Applicants affirm that a new replacement Drawing fulfilling and satisfying the requirements set forth by 37 CFR 1.84 will be submitted at that time.

III. The Rejection Under 35 USC 112, 2nd Paragraph

The Examiners have rejected original claims 7 and 21 respectively as being indefinite in language for failing to make clearly understood in what manner the "magnetic field is generated perpendicular to at least one chosen tooth". After reviewing the recited claim language, applicants' find themselves in agreement with the Examiners' stated view and position.

Accordingly, the language of dependent claims 7 and 21 respectively have been amended to eliminate any latent ambiguity and to clarify the perpendicular directional relationship between the generated magnetic field and the chosen tooth.

Thus, as presently amended, the relevant portion of dependent claims 7 and 21 now recites "... wherein the direction of said substantially uniform magnetic field is generated perpendicular to a surface of at least one chosen tooth in the mouth of the living subject". By this amended claim wording, it will be recognized and appreciated that even though the chosen tooth is a three-dimensional object, its exterior surface will always lie in a particular axis or plane; and the direction of the magnetic field will therefore be generated in a direction perpendicular that particular axis or plane presented

by the tooth surface, whatever its orientation.

Also, as regards the language of these dependent claims as a whole, applicants respectfully submit that these pending claims do, in fact, set out and circumscribe a particular area or subject matter with a reasonable degree of precision and particularity. It is here where the meaning of the language employed to define the invention is determined; not in a vacuum, but always with regard to the teachings of the technical field and within the particular use or application disclosed by the Specification as it is understood and interpreted by one of ordinary skill in the pertinent art.

Applicants affirm that each of the terms used in amended dependent claims 7 and 21 respectively is well understood; and is not subject to numerous definitions and interpretations. Moreover, the language for each of these amended claims is explicit and clearly stated; and sets forth and circumscribes the particular subject matter area with the requisite reasonable degree of precision and particularity.

For these reasons, applicants respectfully submit that amended dependent claims 7 and 21 satisfy the requirements of precision, clarity and particularity required by the 2nd paragraph of 35 USC 112. Accordingly, applicants respectfully request that the Examiners reconsider their stated position and withdraw this ground of rejection against these amended dependent claims.

IV. The Rejections Under 35 USC 102(b) And 103(a)

The Examiners have rejected independent claims 1-2 and 15-17, as well as those dependent claims which depend from them, based on certain cited and applied prior art and by using two different legal grounds for a rejection of these particular claims. Specifically these rejections are: (i) under 35 USC 102(b) as being anticipated by the Miyake *et al.* 2000 article; and (ii) in the alternative, under 35 USC 103(a) as being unpatentable over the Miyake *et al.* 2000 publication in view of the Bales *et al.* '303 patent [U.S. Patent No. 5,233,303]. The Examiners have clearly stated their views and positions in support of each of the two rejection bases.

It will be recognized and appreciated, however, that both of these rejection bases pertain solely to original independent claims 1-2 and 15-17, or those dependent claims which depend from them; and each of the two rejection bases is limited to only these particular original claims, but no others.

On this evidence, therefore, applicants respectfully submit and maintain that the present cancellation of original independent claims 1-2 and 15-17 respectively and the amendment of original claims 3-4, 6-12, 14, and 19-27 respectively has rendered each of these two different bases for rejection irrelevant, immaterial, and moot.

Moreover, it will be noted that only claims 3-14 and 18-27 are presently pending in the instant application. As explicitly reviewed and

considered by the Examiners, the specifically cited and applied prior art references do not detract from the novelty and non-obviousness of the subject matter defined by presently pending claims 3-14 and 18-27 respectively, as amended herein.

Applicants therefore respectfully submit that each and every claim now pending satisfies the novelty requirements of 35 USC 102(b) and the non-obvious requirement of 35 USC 103(a). Accordingly, applicants respectfully request that the Examiners reconsider their stated conclusion and withdraw this ground of rejection against the presently pending claims.

V. Summary Of Applicants' Response


In sum, applicants have addressed each basis of objection and rejection stated in the 1st Official Action forthrightly and objectively. In applicants' view, each relevant question or issue has been acted upon and resolved completely. For these reasons, applicants respectfully submit and affirm that each of presently pending claims 3-14 and 18-27, as amended herein, are therefore allowable.

In view of the above discussion and detailed review, applicants believe that this application is now in condition for allowance and reconsideration is respectfully requested. The Examiners are invited to call applicants' undersigned attorney should they feel that such a telephone call would further the prosecution of the present application.

Respectfully submitted,

HAROLD M. SWARTZ
WILLIAM F.B. PUNCHARD
PIOTR M. STAREWICZ
TADEUSZ M. WALCZAK

Date: Jan. 19, 2006
P.O. Box 5387
Magnolia, MA 0193
Tel.: 978-525-3794
Fax.: 978-525-3791
e-mail: bearbonz@earthlink.net

By: 
David Prashker
Registration No. 29,693
Attorney for applicants